



# UNITED STATES PATENT AND TRADEMARK OFFICE

44  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,722	06/05/2000	Robert I. G. McLean	C1197-991110	7897

26379 7590 02/09/2004

GRAY CARY WARE & FREIDENRICH LLP  
2000 UNIVERSITY AVENUE  
E. PALO ALTO, CA 94303-2248

EXAMINER

COLON, CATHERINE M

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/586,722

Applicant(s)

MCLEAN ET AL.

Examiner

C. Michelle Colon

Art Unit

3623

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The following is a Non-Final Office Action in response to the communication received on November 17, 2003. Claim 1 has been amended. Claims 1-22 are now pending in this application.

### ***Response to Amendment***

2. Applicant's amendment to claim 1 is acknowledged. The amendment is sufficient to overcome the 35 U.S.C. 112, second paragraph rejection set forth in the previous Office Action. Therefore, the 35 U.S.C. 112, second paragraph rejection is withdrawn.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-13 and 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful

arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the recited steps in claims 1-13 and 18-22 of merely processing data relating to the performance of a business enterprise do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in person or by use of a pencil and paper and without the need of a computer or other technology.

As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces outcomes for value streams (i.e., concrete) in order to determine the performance of a business enterprise (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-13 and 18-22 are directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Eder (U.S. 6,321,205).

As per claim 1, Eder discloses a method of processing data relating to the performance of a business enterprise in creating value, comprising:

developing a data structure including assumed variables that have an influence on a value stream of the business enterprise, the assumed variables in said data structure being arranged in a multi-level hierarchy in which assumed variables positioned at a lower level in the hierarchy influence one or more assumed variables positioned at a higher level in the hierarchy (col. 11, lines 15-63; The "Value of current-operation" is comprised of components revenue, expense and capital, which are further comprised of sub-components. Thus, the sub-components influence the components, which influence the value of current-operation.);

determining a first outcome for the value stream of the business enterprise based upon the assumed variables (col. 12, lines 1-30; The component values are calculated to determine the operation value.);

authorizing a user to alter one or more of the assumed variables according to a level of the hierarchy in which the assumed variables are positioned (col. 20, lines 14-22; col. 21, line 34-col. 22, line 8; Users can alter the variables when performing the calculations.); and

determining a second outcome for the value stream of the business enterprise taking into account the altered assumed variables (col. 6, lines 44-64; col. 23, lines 12-

15; The system allows the user to generate changes in the variables when performing the calculations.).

As per claim 2, Eder discloses the method according to claim 1, wherein the first outcome includes a present financial value of the value stream (col. 12, lines 1-30; Revenue, expense and capital are indicative of financial value.).

As per claim 3, Eder discloses the method according to claim 1, wherein the first outcome includes a non-financial metric (col. 19, lines 27-30; Figure 5B; The first outcome can also include non-financial data.).

As per claim 4, Eder discloses the method according to claim 1, further comprising:

authorizing each of a plurality of users to alter the assumed variables according to a level of the hierarchy in which the assumed variables are positioned (abstract; col. 20, lines 14-22; col. 21, line 34-col. 22, line 8; Figure 5A; Users can alter the variables when performing the calculations.);

storing, for each altered assumed variable, an identification of the user who made the alteration (col. 6, lines 44-64; col. 8, lines 1-30; col. 9, line 53-col. 10, line 1; col. 10, lines 6-18; Figures 4, 5A, 5B and 16; Users can track the changes they make in the system over time. User input is also stored in databases.); and

determining alternate outcomes for the value stream of the business enterprise taking into account selected aggregations of the altered assumed variables wherein the selected aggregations are formed according to the stored identifications (col. 6, lines

44-64; col. 20, lines 18-22; Figure 1; The system determines alternate outcomes based on the altered data.).

As per claims 5 and 18, Eder discloses a method of processing data relating to the performance of a business enterprise in creating value, comprising:

developing a data structure including a plurality of assumed variables that have an influence on a value stream of the business enterprise, the data structure having a portion which defines a base case scenario for the business enterprise (col. 11, lines 15-63; The "Value of current-operation" is comprised of components revenue, expense and capital, which are further comprised of sub-components. Thus, the sub-components influence the components, which influence the value of current-operation.);

determining an outcome for the value stream of the business enterprise based upon the assumed variables of the base case scenario (col. 12, lines 1-30; The component values are calculated to determine the operation value.);

altering, by a plurality of users, selected ones of the plurality of assumed variables (col. 20, lines 14-22; col. 21, line 34-col. 22, line 8; Users can alter the variables when performing the calculations.);

storing each altered assumed variable in the data structure in association with an identifier of the user who made the alteration, and maintaining the assumed variables of the base case scenario unchanged by the plurality of users (col. 6, lines 44-64; col. 8, lines 1-30; col. 9, line 53-col. 10, line 1; col. 10, lines 6-18; Figures 4, 5A, 5B and 16; Users can track the changes they make in the system over time. User input is also stored in databases.);

aggregating selected ones of the altered assumed variables and selected ones of the assumed variables of the base case scenario in accordance with the stored identifiers to form one or more alternate scenarios (col. 11, lines 36-52; Resulting values can be added together to form alternate scenarios.); and

determining an outcome for the value stream of the business enterprise based upon each of the alternate scenarios (col. 6, lines 44-64; col. 20, lines 18-22; Figure 1; The system determines alternate outcomes based on the altered data.).

As per claims 6 and 19, Eder discloses the method according to claims 5 and 18, wherein the assumed variables are arranged in a multi-level hierarchy in which assumed variables positioned at a lower level in the hierarchy influence one or more assumed variables positioned at a higher level in the hierarchy (col. 11, lines 15-63; The "Value of current-operation" is comprised of components revenue, expense and capital, which are further comprised of sub-components. Thus, the sub-components influence the components, which influence the value of current-operation.).

As per claims 7 and 20, Eder discloses the method according to claims 6 and 19, wherein said altering further comprises authorizing each of the users to alter the assumed variables according to a level of the hierarchy in which the assumed variables are positioned (col. 20, lines 14-22; col. 21, line 34-col. 22, line 8; Users can alter the variables when performing the calculations.).

As per claims 8 and 21, Eder discloses the method according to claims 5 and 18, wherein the outcome of the base case scenario includes a present financial value of the



value stream (col. 12, lines 1-30; Revenue, expense and capital are indicative of financial value.).

As per claim 9, Eder discloses the method according to claim 8, wherein the outcome of the base case scenario includes a non-financial metric (col. 19, lines 27-30; Figure 5B; The first outcome can also include non-financial data.).

As per claim 10, Eder discloses a method of processing data relating to the performance of a business enterprise in creating value, comprising:

developing a data structure including a plurality of assumed variables that have an influence on a value stream of the business enterprise, the data structure having a portion which defines a base case scenario for the business enterprise (col. 11, lines 15-63; The "Value of current-operation" is comprised of components revenue, expense and capital, which are further comprised of sub-components. Thus, the sub-components influence the components, which influence the value of current-operation.);

determining an outcome for the value stream of the business enterprise based upon the assumed variables of the base case scenario (col. 12, lines 1-30; The component values are calculated to determine the operation value.);

providing real-time feedback, by each of a plurality of users, on the value creation performance of the business enterprise (col. 20, lines 14-22; col. 21, line 34-col. 22, line 8; Users can alter the variables when performing the calculations.);

storing the real-time feedback in the data structure in association with an identifier of the user who provided each portion of the feedback, and maintaining the assumed variables of the base case scenario unchanged by the plurality of users (col.

6, lines 44-64; col. 8, lines 1-30; col. 9, line 53-col. 10, line 1; col. 10, lines 6-18; Figures 4, 5A, 5B and 16; Users can track the changes they make in the system over time.

User input is also stored in databases.);

aggregating selected ones of the portions of the feedback and selected ones of the assumed variables of the base case scenario (col. 11, lines 36-52; Resulting values can be added together to form alternate scenarios.);

determining an outcome for the value stream of the business enterprise based upon the selected ones of the portions of the feedback and the selected ones of the assumed variables of the base case scenario (col. 6, lines 44-64; col. 20, lines 18-22; Figure 1; The system determines alternate outcomes based on the altered data.).

As per claim 11, Eder discloses the method according to claim 10, wherein the assumed variables are arranged in a multi-level hierarchy in which assumed variables positioned at a lower level in the hierarchy influence one or more assumed variables positioned at a higher level in the hierarchy (col. 11, lines 15-63; The "Value of current-operation" is comprised of components revenue, expense and capital, which are further comprised of sub-components. Thus, the sub-components influence the components, which influence the value of current-operation.).

As per claim 12, Eder discloses the method according to claim 10, wherein the outcome of the base case scenario includes a present financial value of the value stream (col. 12, lines 1-30; Revenue, expense and capital are indicative of financial value.).

As per claim 13, Eder discloses the method according to claim 10, wherein the outcome of the base case scenario includes a non-financial metric (col. 19, lines 27-30; Figure 5B; The first outcome can also include non-financial data.).

As per claim 14, Eder discloses a system for processing data relating to the performance of a business enterprise in creating value, comprising:

a memory device for storing a data structure including assumed variables that have an influence on a value stream of the business enterprise, the assumed variables in said data structure being arranged in a multi-level hierarchy in which assumed variables positioned at a lower level in the hierarchy influence one or more assumed variables positioned at a higher level in the hierarchy (col. 11, lines 15-63; The "Value of current-operation" is comprised of components revenue, expense and capital, which are further comprised of sub-components. Thus, the sub-components influence the components, which influence the value of current-operation.);

means for authorizing a user to alter one or more of the assumed variables according to a level of the hierarchy in which the assumed variables are positioned (col. 20, lines 14-22; col. 21, line 34-col. 22, line 8; Users can alter the variables when performing the calculations.);

a filter for selecting certain ones of the assumed variables and for selecting certain ones of the altered assumed variables (col. 12, lines 44-67; col. 16, lines 24-27; Figures 5A and 5B; The system selects certain variables for analysis and based on certain criteria may prompt the user for additional or altered data.); and

a calculation engine for receiving the certain ones of the assumed variables and the certain ones of the altered assumed variables from the filter and for determining an outcome for the financial value stream of the business enterprise based upon the certain ones of the assumed variables and the certain ones of the altered assumed variables (col. 6, lines 44-64; col. 23, lines 12-24; The system calculates the received variables and compares them with previously specified variables.).

As per claim 15, Eder discloses the system according to claim 14, wherein the outcome of the base case scenario includes a present financial value of the value stream (col. 12, lines 1-30; Revenue, expense and capital are indicative of financial value.).

As per claim 16, Eder discloses the system according to claim 14, wherein the outcome of the base case scenario includes a non-financial metric (col. 19, lines 27-30; Figure 5B; The first outcome can also include non-financial data.).

As per claim 17, Eder discloses the system according to claim 14, further comprising:

means for authorizing each of a plurality of users to alter the assumed variables according to a level of the hierarchy in which the assumed variables are positioned, wherein for each altered assumed variable, an identification of the user who made the alteration is stored in the data structure (abstract; col. 20, lines 14-22; col. 21, line 34-col. 22, line 8; Figure 5A; Users can alter the variables when performing the calculations.);

means for determining alternate outcomes for the value stream of the business enterprise taking into account selected aggregations of the altered assumed variables wherein the selected aggregations are formed according to the stored identifications (col. 6, lines 44-64; col. 8, lines 1-30; col. 9, line 53-col. 10, line 1; col. 10, lines 6-18; col. 20, lines 18-22; Figure 1, 4, 5A, 5B and 16; The system determines alternate outcomes based on the altered data. Users can track the changes they make in the system over time. User input is also stored in databases.).

As per claim 22, Eder discloses the method according to claim 18, wherein the outcome of the base case scenario includes a non-financial metric (col. 19, lines 27-30; Figure 5B; The first outcome can also include non-financial data.).

### ***Response to Arguments***

7. Applicant's arguments are moot in view of the new grounds of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Thursday from 8:30am to 5:30pm and every other Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Art Unit: 3623

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

703-305-7687 [Official Communications; including After Final  
communications labeled "Box AF"]

703-746-7202 [For status inquiries, draft communication, labeled  
"Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA 7<sup>th</sup> floor receptionist.

  
cmc

February 3, 2004

*Susanna Diaz*  
*Susanna Diaz*  
*Primary Examiner*  
*Art. 3623*